

### **Arguments/Remarks**

Claims 31-53 were objected to as being an improper Markush group, citing *In re Harnisch* in support. But the court in *In re Harnisch* held that the claims at issue (directed towards dyes written in Markush format similar to the present claims) were a proper Markush group because they shared a common utility (as dyes) having structural similarity, and the grouping was not “repugnant to scientific classification.” Similarly, the compounds of the present Markush claims share a common utility as kinase inhibitors, share structural similarity as manifested in structural formula I of claim 31, and, the applicants submit, the grouping is not repugnant to scientific classification.

The Office asserts *Harnisch* requires that the common structural feature be essential for the common utility. But *Harnisch* does not make such a requirement. The *Harnisch* holding was based solely on common utility, common structural feature, and a grouping not repugnant to scientific classification:

We conclude that the board here was factually in error in not recognizing that all of appellant's claimed compounds are dyes, as confirmed by the solicitor's admission. The board's reliance on its notion that some of the claimed compounds are “no more than intermediates” overlooked the now admitted fact that they are dyes as well. Clearly, they are all coumarin compounds which the board admitted to be “a single structural similarity.” We hold, therefore, that the claimed compounds all belong to a subgenus, as defined by appellant, which is not repugnant to scientific classification. Under these circumstances we consider the claimed compounds to be part of a single invention so that there is unity of invention as was held to be the case in *Ex parte Brouard*, supra, 201 USPQ at 540. The Markush groupings of claims 1 and 3-8 are therefore proper.

*In re Harnisch*, 206 USPQ 300, 305 (C.C.P.A. 1980).

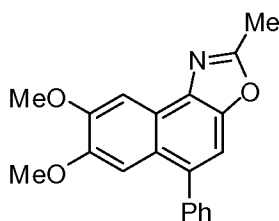
In addition, in paragraph 8 of the Office Action the Office asserts the compounds of the present claims possess widely different physical and chemical properties, are not considered functionally equivalent, and are “so diverse that they demonstrate dissimilar and unrelated properties.” First, the Office failed to provide any factual support for these assertions. Second, and moreover, the Office failed to explain these assertions while at the same time failing to recognize that the common structural features of the claims compounds as manifested in formula I of claim 31 and the common utility as kinase inhibitors.

That the compounds may also possess dissimilar properties is not fatal to their grouping in a Markush claim. Indeed, the *Harnisch* court cited approvingly to *In re Jones*, 162 F.2d 479,

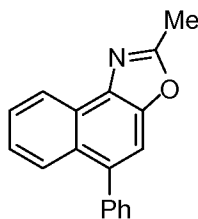
74 USPQ 149 (C.C.P.A. 1947), where that court held that a Markush claim to chemical compounds was proper because they all shared a common utility as plant stimulants “[n]otwithstanding their various properties” and acknowledging that the compounds “will differ from each other in certain respects.”

Claims 51 and 52 were rejected under 35 USC § 112, second paragraph, as indefinite because periods were missing from the end of the claims. Claims 51 and 52 have been amended by adding periods at the end, thereby obviating this rejection.

Claims 31-34 and 53 were rejected as anticipated by Tikk *et al.* (Reference U, cited by the Examiner) for its disclosure of the following compound:



and as anticipated by Tikk *et al.* (Reference V, as cited by the Examiner) for its disclosure of the following compound:



The claims have been amended such that X<sup>3</sup> no longer includes –O– or –S–. As such, the cited compounds of the Tikk *et al.* publications no longer anticipate the claims. Accordingly, the applicants respectfully request reconsideration and withdrawal of these rejections.

The applicants having overcome the prior art rejections, search and examination should be expanded to the full scope of the claims (or until additional prior art is found sufficient to impose a rejection under 35 USC § 102 or 103), as required by MPEP 803.02.

Paragraph 19 merely states that claims 35-50 are object to without providing the reason for the objection. The applicants presume this paragraph merely reiterates that these claims are objected to as described in paragraphs 7 *et seq.* but not otherwise rejected. If the applicants’ understanding is incorrect, clarification is respectfully requested.

If it is believed that a teleconference will advance prosecution, the examiner is encouraged to contact the undersigned as indicated below.

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Respectfully submitted,

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